

PATENT

Atty. Dkt. No. YOR920010137US1

REMARKS

In view of the following discussion, the Applicants submit that none of the claims now pending in the application are anticipated under the provisions of 35 U.S.C. §102 or obvious under the provisions of 35 U.S.C. §103. Thus, the Applicants believe that all of the presented claims are in condition for allowance.

I. REJECTION OF CLAIMS 1, 3-20, AND 22-34 UNDER 35 U.S.C. § 102

The Examiner rejected claims 1, 3-20, and 22-34 as being anticipated under 35 U.S.C. §102(e) by the Donahue patent (United States Patent No. 7,024,397, issued April 4, 2006, hereinafter "Donahue"). In response, the Applicants have amended independent claims 1, 8, 12, 15, 28, and 31 from which claims 3-6, 9-11, 13-14, 16-20, 22-27, 29, and 32 depend, as well as independent claim 33, in order to more clearly recite aspects of the present invention. Claims 30 and 34 have been cancelled without prejudice. Applicants do not concede that the subject matter encompassed by claims 30 and 34 is not patentable over the art cited by the Examiner; rather, claims 30 and 34 were cancelled solely to facilitate expeditious prosecution of the pending claims. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by cancelled claims 30 and 34 and additional claims, in one or more continuing applications.

Primarily, the Applicants respectfully submit that Donahue fails to teach, show, or suggest the novel invention of conducting a fully automated negotiation between computing systems (i.e., without user participation or control), as recited in Applicants' independent claims 1, 8, 12, 15, 28, 31, and 33.

By contrast, Donahue teaches a system in which a real estate lease is negotiated over a computer network by human users controlling networked devices. For instance, "[t]he negotiators use a web browser to answer predefined questions regarding a proposed transaction ..." (Donahue, Abstract, emphasis added). Thus, the lease is negotiated under the control of the users; i.e., the lease cannot be negotiated independently by the networked devices in a fully automated manner, as claimed by the Applicants.

Specifically, Applicants' claims 1, 8, 12, 15, 28, 31, and 33 positively recite:

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1. A method for automating contract negotiation between a first party having a first computing system and a second party having a second computing system, each of the first computing system and the second computing system being coupled to a communications network and having one or more applications running thereon, the method comprising the steps of:

establishing a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the first party and the second party prior to the contract negotiation;

conducting a pre-negotiation between the first party and the second party to form a negotiation meta contract to control the contract negotiation, in accordance with the negotiation protocol, wherein the meta contract is formed at least in part from information provided by at least one of the first party and the second party in at least one electronic document, prior to the negotiation;

communicating a request to negotiate; and

conducting a fully automated negotiation, according to the negotiation meta contract, between the one or more applications running on each of the first computing system and the second computing system,

wherein each of the first computing system and the second computing system maintains a contract state of the negotiation. (Emphasis added)

8. A method for conducting a negotiation between a first party having a first computer system and a second party having a second computer system, each of said first computer system and the second computer system being coupled to a communication network and having one or more applications running thereon, the method comprising the steps of:

providing a specification of machine-executable rules of negotiation for the first computing system and the second computing system for generating at least one contract, the specification being agreed upon by the first party and the second party prior to conducting the negotiation;

conducting a pre-negotiation between the first party and the second party to form a starting state for a contract in accordance with the specification, wherein the starting state is formed at least in part from information provided by at least one of the first party and the second party in at least one electronic document, prior to the negotiation, the at least one electronic document being selectable from one of: a previous contract, a publicly defined template, and a template defined prior to the negotiation by one of the first party and the second party; and

conducting a fully automated negotiation, according to the starting state, between the one or more applications running on each of the first computing system and the second computing system,

wherein each of the first computing system and the second computing system maintains a contract state of the negotiation. (Emphasis added)

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12. A method for conducting an automatic negotiation between a first party having a first computer system and a second party having a second computer system, each of said first computer system and the second computer system being coupled to a communication network and having one or more applications running thereon, the method comprising the steps of:

establishing a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the first party and the second party prior to the negotiation;

conducting a pre-negotiation between the first party and the second party to form a template prior to the negotiation in accordance with the negotiation protocol, wherein the template is formed at least in part from information provided by at least one of the first party and the second party in at least one electronic document, prior to the negotiation, wherein the template contains business logic for performing a negotiation electronically;

registering the business logic, prior to the negotiation, with a server accessible by one or more of the first party and the second party; and

implementing the business logic in a fully automated negotiation conducted between the first computer system and the second computer system over the communication network,

wherein each of the first computer system and the second computer system maintains a contract state of the negotiation. (Emphasis added)

15. A method for conducting a negotiation between a first party having a first server and a second party having a second server, each of said first server and the second server being coupled to a communication network and having one or more applications running thereon, comprising the steps of:

providing a specification of machine-executable rules of negotiation for the first server and the second server for generating at least one contract, the specification being agreed upon by the first party and the second party prior to conducting the negotiation;

enabling a fully automated negotiation to take place between the first server and the second server in accordance with the specification of machine-executable rules; and

conducting a pre-negotiation between the first party and the second party to form a meta contract for controlling the fully automated negotiation in accordance with the specification, wherein the meta contract is formed at least in part from information provided by at least one of the first party and the second party in at least one electronic document, prior to the negotiation,

wherein each of the first server and the second server maintains a contract state of the negotiation. (Emphasis added)

28. A method for conducting a negotiation between a first party having a first computer system and a second party having a second computer system, each of

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said first computer system and the second computer system being coupled to a communication network and having one or more applications running thereon, comprising the steps of:

providing a specification of machine-executable rules of negotiation for the first computer system and the second computer system for generating at least one contract, the specification being agreed upon by the first party and the second party prior to conducting the negotiation;

conducting a pre-negotiation between the first party and the second party to form a meta contract to control the negotiation, in accordance with the specification, wherein the meta contract is formed at least in part from information provided by at least one of the first party and the second party in at least one electronic document, prior to the negotiation; and

enabling a fully automated negotiation to take place between the first computer system and the second computer system in accordance with the specification of machine-executable rules;

wherein a third party having a third computer system is an intermediary for facilitating the a fully automated negotiation,

wherein each of the first party, the second party, and the third party maintains a contract state of the negotiation. (Emphasis added)

31. A method of conducting a negotiation over a data communication network between a service provider having a server computing system and a service requester having a client computing system, comprising the steps of:

establishing, by the service provider and the service requester, a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the service provider and the service requester prior to the contract negotiation;

conducting a pre-negotiation between the service provider and the service requester to form a negotiation meta-contract to control the negotiation, in accordance with the negotiation protocol, wherein the meta contract is formed at least in part from information provided by at least one of the service provider and the service requester in at least one electronic document, prior to the negotiation;

receiving, at the server computing system, a request to negotiate from the client computing system;

responsive to the request to negotiate, conducting a fully automated negotiation with the client computing system by the server computing system in accordance with the negotiation meta-contract,

wherein each of the server computing system and the client computing system maintains a contract state of the negotiation. (Emphasis added)

33. A method of conducting business over the Internet, wherein a first party and a second party negotiate contractual terms between a first data

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communication network component and a second data communication network component, the method comprising the steps of:

providing a specification of machine-executable rules of negotiation for generating at least one contract, the specification being agreed upon by the first party and the second party prior to negotiating the contractual terms;

conducting a pre-negotiation between the first party and the second party to form a meta contract to control negotiating, in accordance with the specification, wherein the meta contract is formed at least in part from information provided by at least one of the first party and the second party in at least one electronic document, prior to negotiation; and

originating a fully automated negotiation at the first data communication network component in accordance with the rules of negotiation,

wherein each of the first data communication network component and a second data communication network component maintains a contract state of the negotiation. (Emphasis added)

Since Donahue does not teach or suggest conducting a fully automated negotiation between computing systems (i.e., without user participation or control), Donahue does not teach each and every element of Applicants' amended independent claims 1, 8, 12, 15, 28, 30, and 33. Moreover, dependent claims 3-6, 9-11, 13-14, 16-20, 22-27, 29, and 32 depend, either directly or indirectly, from independent claims 1, 8, 12, 15, 28, and 31 and recite additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claims 3-6, 9-11, 13-14, 16-20, 22-27, 29, and 32 are also not anticipated and are allowable.

Therefore, Applicants contend that claims 1, 3-6, 8-20, and 22-29, and 31-33 are patentable over Donahue and, as such, fully satisfy the requirements of 35 U.S.C. §102. Thus, Applicants respectfully request that the rejection of claims 1, 3-6, 8-20, and 22-29, and 31-33 under 35 U.S.C. §102 be withdrawn.

II. REJECTION OF CLAIM 21 UNDER 35 U.S.C. § 103

The Examiner rejected claim 21 as being unpatentable under 35 U.S.C. §103(a) over Donahue. The Applicants respectfully traverse the rejection.

As discussed above, Donahue fails to teach or suggest the novel invention of conducting a fully automated negotiation between computing systems (i.e., without user participation or control), as recited in Applicants' amended independent claim 15.

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Dependent claim 21 depends from independent claim 15 and recites additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claim 21 is also not made obvious and is allowable. Therefore, Applicants contend that claim 21 is patentable over Donahue and, as such, fully satisfies the requirements of 35 U.S.C. §103. Thus, Applicants respectfully request that the rejection of claim 21 under 35 U.S.C. §103 be withdrawn.


III. CONCLUSION

Thus, the Applicants submit that all of the presented claims fully satisfy the requirements of 35 U.S.C. §102 and 35 U.S.C. §103. Consequently, the Applicants believe that all of these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the maintenance of the final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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